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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,300	03/12/2004	Atsumi Kobayashi	D-1591	5790

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EXAMINER

NICHOLSON III, LESLIE AUGUST

ART UNIT

PAPER NUMBER

3651

DATE MAILED: 12/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/798,300	KOBAYASHI, ATSUMI
	<b>Examiner</b>	<b>Art Unit</b>
	Leslie A. Nicholson III	3651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 24 October 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-15 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 12 March 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1 (see ¶8) is rejected under 35 U.S.C. 102(b) as being anticipated by Taruki JP 09292742.

Taruki discloses a similar document transport apparatus comprising:

- A sheet feeding tray (5) and a sheet discharging tray (23)
- Sheet feeding means (7) being disposed at one side of the document transport apparatus
- Transport means (16) disposed adjacent to the sheet feeding means
- Sheet discharging means (38) disposed adjacent to the transport means at a side opposite to the sheet feeding means and located at the other side of the document transport apparatus (fig.1)
- A switch back path (20,21) disposed adjacent to the sheet discharging means and located between the transport means and the sheet discharging tray
- A sheet discharging path (22) disposed adjacent to the sheet discharging means

3. Claims 8 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Dinatale USP 4,884,794.

Dinatale discloses a similar document transport method comprising:

- drawing a document from a sheet feeding tray (26) in a condition such that one edge of the document becomes a leading edge (C15/L15-16)
- transporting the document directly to a predetermined position on a platen (12) in a condition such that said one edge of the document is said leading edge (C15/L15-17)
- guiding the document after one side thereof is read to a switch back path (40), said switch back path turning the document upside down, and reversing a leading end and a trailing end of the document (C15/L23-25; C13/L39-49)
- transporting the document from the switch back path toward a sheet discharging tray (C10/L58-68, C11/L1-5)
- changing a transporting direction of the document before the document is completely discharged to the sheet discharging tray (path 40b) (C13/L39-49)
- guiding the document that the transporting direction is changed to a U turn path (guided towards 36) to transport the document to the predetermined position on the platen again (C15/L28-40)
- transporting the document to the U turn path (36) after the other side of the document is read (C10/L47-51)
- discharging the document to the sheet discharging tray (38)

Regarding claim 14, Dinatale further discloses the method wherein said switch

back path includes a gap (path 40a) so that the document sent into the gap in one direction is sent out in a direction opposite to said one direction (path 40b) (the two paths guide the sheet in opposite directions) (C10/L58-66).

4. Claims 9 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Rubscha USP 5,511,771.

Rubscha discloses a similar document transport method comprising:

- drawing a document (18) from a sheet feeding tray (20) in a condition such that one edge of the document becomes a leading edge (C4/L13-14)
- transporting the document directly to a predetermined position on a platen (12) in a condition such that said one edge of the document is said leading edge (C4/L15-17) (path 25)
- guiding the document after one side thereof is read to a U turn path (path 25, between the imaging station and discharging tray is generally U-shaped) to thereby transport the document toward a sheet discharging tray (22) (C5/L29-37)
- changing a document transfer direction before the document is completely discharged to the sheet discharging tray (C5/L29-40)
- guiding the document after one side thereof is read to a switch back path (27) said switch back path, said switch back path turning the document upside down, and reversing a leading end and a trailing end of the document (C5/L29-45)
- transporting the document from the switch back path to a predetermined position on the platen (path 26)

- transporting the document to the U turn path after the other side of the document is read (path 26)
- discharging the document to the sheet discharging tray (C4/L20-28)

Regarding claim 15, Rubscha further discloses the method wherein said switch back path includes a gap (27) so that the document sent into the gap in one direction is sent out in a direction opposite to said one direction (by following path 26, the direction back to the discharging tray is opposite to the direction of the sheet when fed through gap 27) (C5/L36-46).

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2,3,4,5,7,10,11,12, and 13 (see ¶8) are rejected under 35 U.S.C. 103(a) as being unpatentable over Taruki JP 09292742.

Regarding claims 2,4, and 11, Taruki discloses all the limitations of the claim (see ¶2) but is silent about the apparatus further comprising control means electrically connected to the transport means and the sheet discharging means and wherein the control means controls the transport means and the sheet discharging means.

However, because it is described as an automatic document feeder (title), it is obvious to one of ordinary skill in the art at the time of invention that the automatic

document feeder comprises control means electrically connected to transport means and sheet discharging means and wherein the control means controls the transport means and the sheet discharging means.

Regarding claim 3, Taruki discloses the apparatus wherein the discharging tray is located below the sheet feeding tray and above the platen (fig.1).

Regarding claim 5, Taruki discloses the apparatus further comprising a guide member (34) disposed at a discharge side of the platen.

Regarding claim 7, Taruki further discloses the apparatus wherein the sheet discharging means include a pair of sheet discharging rollers (38) and the discharge path is located between the platen (3) and the pair of sheet discharging rollers and branched from the switch back path (fig.1).

Regarding claim 10, Taruki discloses a similar image reading apparatus comprising a document transport apparatus (1), a platen (3), and reading means (2) (fig.1).

Regarding claim 12, Taruki further discloses the apparatus wherein said switch back path includes a first portion (20) extending to a portion adjacent to the transport means, a second portion (21) extending toward the sheet discharge path, and a gap (24) disposed between the first and second portions (fig.1).

Regarding claim 13, Taruki further discloses the apparatus wherein said sheet discharging path includes a U turn path connecting the first and second portions without passing the gap (abstract) (fig.1).

7. Claim 6 (see ¶8) is rejected under 35 U.S.C. 103(a) as being unpatentable over Taruki JP 09292742 in view of Yano USP 6,467,767.

Taruki discloses all the limitations of the claim (see ¶6) but does not disclose the apparatus wherein the switching means includes a torque limiter disposed on a driving shaft of a transporting roller.

Yano teaches a torque limiter disposed on a driving shaft of a transporting roller for the purpose of transmitting a driving force of predetermined torque to the roller (C14/L4-8).

At the time of invention it would have been obvious to one having ordinary skill in the art to have used a torque limiter disposed on a driving shaft of a transporting roller, as taught by Yano, in the device of Taruki, for the purpose of transmitting a driving force of predetermined torque to the roller.

***Examiner's Note***

8. The applicant appears to be attempting to use means plus function in claims 1-7 and 10-13. Does the applicant intend to invoke 35 USC 112 6<sup>th</sup> paragraph? The examiner has construed this claim as to not invoking 35 USC 112 6<sup>th</sup> paragraph. See MPEP 2114 and 2181.

***Response to Arguments***

9. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

Due to the amendments to the specification, the objections to the drawings and specification are hereby withdrawn.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie A. Nicholson III whose telephone number is 571-272-5487. The examiner can normally be reached on M-F, 8:30 AM - 5 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on 571-272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

L.N.  
12/6/2005

  
GENE O. CRAWFORD  
SUPERVISORY PATENT EXAMINER